

REMARKS

The foregoing amendments and the following remarks are submitted in response to the communication dated January 28, 2005.

Status of the Claims

Claims 29-31 and 67-73 are pending in the application. Claims 29, 30, 31, 67, 68, 69 and 70 have been amended in order to more particularly point out and distinctly claim that which Applicants regard as the invention. In addition, Applicants have amended withdrawn claims 67-70, which are withdrawn, process claims, to include the limitations of the product claims. Support for the amended claims can be found generally through Applicants' specification.

New Rejection

New Claim Rejections – 35 U.S.C. §112

Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim that which Applicant regards as the invention. The Examiner asserts that claim 29 is indefinite because it encompasses an isolated DNA molecule, which is amplifiable with a PCR probe, particularly under non-specified circumstances without clear metes and bounds. Applicants respectfully disagree and assert that a molecule amplifiable by PCR with specified and particular primers is clear to the skilled artisan, as the artisan would know and understand the standard and recognized conditions for PCR amplification. In addition, the Specification, including at pages 81-82, provides exemplary conditions for PCR amplification using the specified primers. Applicants, however, have above amended claim 29, without prejudice to continued prosecution, and submit that the claims as now presented are not indefinite. In particular, reference to amplifiable and hybridizable nucleic acids has been deleted from the claim 29 language. Applicants submit that the above amendment overcomes and makes this rejection moot, in as much as the rejected language has been deleted from claim 29. Applicants request that the new 35 U.S.C. §112, second paragraph, rejection be withdrawn.

Maintained Rejections

The Specification Fully Enables the Claimed Invention

Claims 29-31 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully disagree and submit that the Specification provides a precise definition of the oligonucleotides claimed. Applicants further point out that amendments have above been made to claims 29 and 30, without prejudice, and assert that the claims as presented are fully enabled under 35 U.S.C. 112, first paragraph, and meet the written description requirements, setting out a precise definition of the claimed oligonucleotides.

In view of the foregoing remarks and amendment, Applicants submit that the Examiner's rejections under 35 U.S.C. 112, first paragraph, may properly be withdrawn.

The 35 USC § 102 Rejection

Claims 29-31 remain rejected under 35 U.S.C. 102(e) as being anticipated by Tartaglia et al U.S. Patent No. 6,506,877, filed December 28, 1995. The Examiner asserts that the nucleic acid of Tartaglia et al would be hybridizable to a DNA molecule of SEQ ID NO: 9, therefore anticipating the instantly claimed oligonucleotides, Applicants respectfully disagree. Applicants again assert that Tartaglia does not teach or anticipate the particular soluble receptor(s) claimed by Applicants. The Examiner agrees that Tartaglia teaches that inventions of functional domains can be made, however, this limited suggestion does not anticipate the soluble receptor(s) of the instant Application, particularly in as much as the C-terminal sequence of this soluble receptor diverges after His⁷⁹⁶. Applicants pending claims are directed to oligonucleotides specifically hybridizable to nucleic acids encoding the soluble leptin receptors OB-Re (SEQ ID NO:10) or amino acids 28-805 of SEQ ID NO:10. The Specification, including in Example 3 at pages 80-82 and in TABLE 1, contemplates and describes oligonucleotides (PCR primer probes) specifically hybridizable to species variants of OB-R, such oligonucleotides useful to identify unique splice variants. The Specification further

teaches the sequence of OB-Re species variant soluble receptor, and particularly outlines and provides its divergent sequence. This divergent sequence is sequence, which was not described or contemplated in the Tartaglia et al reference. The skilled artisan can readily identify, test, and utilize oligonucleotides specifically hybridizable to the OB-Re sequence, including as taught and described in the Specification. The claims as now presented are not taught or anticipated by Tartaglia et al.


In view of the foregoing remarks and amendments, Applicants submit that the Examiner's rejection under 35 U.S.C. 102 may properly be withdrawn.

CONCLUSION

Applicants respectfully request entry of the foregoing amendments and remarks in the file history of the instant Application. The Claims as amended are believed to be in condition for allowance, and reconsideration and withdrawal of all of the outstanding rejections is therefore believed in order. Early and favorable action on the claims is earnestly solicited.

Respectfully submitted,

KLAUBER & JACKSON

A handwritten signature in black ink, appearing to read "Christine E. Dietzel", is written over the printed name.

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